



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,762	11/09/2001	Petter Ericson	3782-0196P	5644

2292 7590 03/14/2006

BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
----------

TRAN, HENRY N

ART UNIT	PAPER NUMBER
----------	--------------

2674

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/986,762

Applicant(s)

ERICSON ET AL.

Examiner

Henry N. Tran

Art Unit

2674

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-17 and 26-29 is/are allowed.
- 6) ☒ Claim(s) 1-7, 10, 13, 14, 18-20 and 30 is/are rejected.
- 7) ☒ Claim(s) 8, 9, 11, 12 and 21-25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Prosecution on the merits of this application is reopened on claims 1-7, 10, 13, 14, 18-20 and 30 considered unpatentable for the reasons indicated below:

The indicated allowability of claims 1-7, 10, 13, 14, 18-20 and 30 is withdrawn in view of the newly discovered reference(s) to Lewis et al (U.S. Patent No. 5,294,792). Rejections based on the newly cited reference(s) follow.

#### ***Claim Objections***

2. Claim 26 is objected to because of the following informalities: The status of claim 26 should be changed to "Previously Presented" instead of "Currently Amended". Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 6, 10, 18-20, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Lewis et al (U.S. Patent No. 5,294,792).
5. Regarding claim 1, Lewis et al. disclose a handheld device (Figures 2 & 5) for recording a track of handwritten information (column 1, lines 6-10) comprising: an information management

Art Unit: 2674

unit (reads on HPR chip; column 4, lines 5-29); means for recording said information in a digital format and a memory for storing the same (column 3, line 62-column 4, line 4; col. 12, lines 46-50; and column 12, lines 56-59), wherein, the memory includes: a first memory unit (reads on recognized memory) located in the pen device (Figure 2, column 4, lines 14-17; column 12, lines 56-59), and a second memory unit located in an external data storage device, which memory units are connected in such a way that a transmission of said recorded information is caused to occur automatically from the first memory unit to the second memory unit, and through transmission of the recorded information from the first memory unit to the second memory unit, the recorded information can exceed the storage capacity of the first memory unit and thereby, from the point of view of the user, the first memory unit and the second memory unit form a coherent memory unit (column 4, lines 28-58; column 12, lines 59-63).

6. Regarding claims 2 and 4, Lewis et al. discloses the handheld pen device according to claim 1, further comprising a means for transmission (pen transmitter; Figures 2 & 5) of information between the first and second memory unit, the first memory unit being arranged to receive and store the recorded information from the recording means and the information transmission means being arranged to transfer according to predetermined rules (read on memory full determination) at least a subset of the recorded information from the first to the second memory unit for storage therein (column 4, lines 28-58; column 12, lines 59-63).

7. Regarding claim 3, Lewis et al. further discloses the pen device in which the information transmission means is arranged to carry out exclusively one-way transmission of information from the first (recognized memory) to the second memory unit since the programs uploaded to

Art Unit: 2674

the pen device are in memory devices distinct from the recognized memory (Figure 2; column 4, lines 28-58; column 12, lines 59-63).

8. Regarding claim 6, Lewis et al. further discloses that the hand-held pen device may be used to transfer input data to the host computer without the use of a physical wire which suggest that information transmission means is arranged to carry out wireless transmission of information from the pen device (column 4, lines 63-67; column 8, lines 4-6).

9. Regarding claim 10, Lewis et al. discloses the hand-held pen device of claim 1, in which the recorded information comprises a plurality of absolute positions that form an electronic version of the handwritten information (column 10, lines 12-27; column 10, lines 46-68).

10. Regarding claims 18-20 and 30, which comprises substantially the same claim elements and limitations as claims 1-3; and are rejected using the same rationale.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 5, 7, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis et al. (U.S. Patent No. 5,294,792) in view of O'Connor et al (U.S. Patent No. 6,188,392).

Lewis et al teaches generally all as discussed above, and further teaches the use of a ring of capacitive coupled device (CCD) and lens system as image sensor means for optical recording handwritten information at a particular position (Figure 6; column 12, line 64 to column 13,

Art Unit: 2674

line15); except: (i) said rules comprise transferring said information when this has been stored in the first memory unit for a certain period of time; (ii) the information means is arranged to transfer all the recording information to the second memory unit; (iii) the second memory unit has a data storage capacity that is considerably larger than the data storage capacity of the first memory unit; and (iv) said means for recording handwritten information comprises an image sensor for optical recording of a position code on a base.

O'Connor et al discloses a hand-held pen device for recording a track of handwritten information created by the pen device, comprising: (i) rules comprise transferring said information when this has been stored in the first memory unit for a certain period of time; (ii) the information means is arranged to transfer all the recording information to the second memory unit; (iii) the second memory unit has a data storage capacity that is considerably larger than the data storage capacity of the first memory unit (O'Connor teaches that the pen 100 having a memory unit 120 and a personal computer PC 130 that downs load digital information stored in the memory unit 210; wherein, the pen internal memory120 whose storage capacity can be afforded to stored accumulated pen data over a certain period of time, e.g. a day, for transmitting to the PC; see Figures 1 and 2; col. 1, lines 52-54; col. 5, lines 57-61; and col. 6, lines 23-35; and Official notice is taken for the claim limitation "an image sensor for optical recording of a position code on a base" because that is old and well known in the art (see Lazzouni et al, U.S. Patent No. 5,661,506, Figure 10, for the use of an image system (36) arranged in the pen (10) for recording a position code on a base (paper 14)).

Art Unit: 2674

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of O'Connor et al discussed above in the Lewis et al. device because this would provide an improved compact pen input device, which has a memory for conveniently and effectively recording pen input information for transmitting to a computer, and which is autonomous and easily to use, see O'Connor et al, col. 1, lines 48-55.

By this rationale, claims 5, 7, 13 and 14 are rejected.

***Allowable Subject Matter***

13. Claims 15-17 and 26-29 are allowed.

14. Claims 8, 9, 11, 12 and 21-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

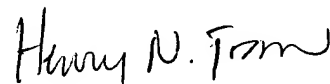
***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry N. Tran whose telephone number is 571-272-7760. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick N. Edouard can be reached on 571-272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2674

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Henry N Tran  
Primary Examiner  
Art Unit 2674

HT